

Appln No. 09/113,094

Amdt. Dated November 10, 2005

Response to Office Action of September 30, 2005

2

REMARKS/ARGUMENTS

We refer to the Office Action dated September 30, 2005. In response to the issues raised, the Applicant offers the following submissions.

35 U.S.C. §103 - Claims 1-4

Claims 1-4 stand rejected as obvious in light of US 5,894,326 to McIntyre et al. in view of US 5,233,414 to Kojima in further view of US 5,999,203 to Cane et al.

The Applicant strongly disagrees. In response to our submissions of August 8, 2005, the Examiner argues that an obviousness rejection based on a combination of documents can not be rebutted by attacking each citation individually. This is well established, and the Applicant appreciates that the rejection is not based on the individual disclosures, but rather that the combined disclosures anticipate all the elements defined in claim 1. However, a fundamental pre-requisite for all rejections based on combined documents, is the existence of some motivation for the ordinary worker to make the cited combination. This motivation must be derived from each of the documents themselves. If there is no motivation to add one of the references to the combination, then the rejection fails.

In light of this, it is proper to examine the teachings of each individual document to determine what motivations or incentives they would suggest to the ordinary worker. Otherwise, the mere fact that the citations can be combined would be sufficient to support the rejection. But this is not the case - the prior art must also suggest the desirability of the combination.

A lack of motivation to combine references clearly exists where one or more of the cited reference teaches away from the proposed combination. Furthermore, if the proposed combination would modify one of the cited references such that it is unable to achieve its intended purpose, there can be no suggestion or motivation to modify the reference with the teachings the other. See *In re Gordon*, 733 F.2d 900 (Fed.Cir. 1984); *Tec Air Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed.Cir.1999).

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3

Such is clearly the case in the present rejection. McIntyre et al identifies the main shortcoming of the prior art as the artifacts in the hard copies of prints caused by printers "which provide relative movement of a head and a media sheet" (see column 1, lines 38-42). The stated object of the invention is to address this problem, and the invention provides an electronic camera with a direct optical printer in order to achieve that object. To then modify the McIntyre camera so that it has an inkjet printer instead of a direct optical printer would render it unsatisfactory for its stated purpose.

Accordingly, there is a clear motivation in McIntyre not to incorporate the teachings of Cane. Therefore, regardless of what motivations or suggestions can be gained from Cane or Kojima, McIntyre argues that the combination is undesirable. Without the necessary motivation to combine the cited documents, the combination of elements defined by claim 1 would not have been obvious to the ordinary worker. It follows that appended claims 2-4 are likewise non-obvious in view of the cited combination.

Conclusion

It is respectfully submitted that the Examiner's rejections have been successfully traversed and the application is in condition for allowance. Accordingly, favorable reconsideration is courteously solicited.

Very respectfully,

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